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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/751,269

**Applicant(s)**

RHOADS ET AL.

**Examiner**

FARHAN M. SYED

**Art Unit**

2165

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date See Office Action.

**DETAILED ACTION**

1. Claims 1-21 are pending. Claims 15-21 were previously withdrawn. The Examiner acknowledges amended claims 3, 10, 12, and 13.

***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on 05 June 2008 and 25 January 2009, respectively, are being considered by the examiner.

***Response to Remarks/Argument***

3. Applicant's arguments, see page 7, filed 04 November 2008, with respect to claims 10-14 have been fully considered and are persuasive. The claim objections of a Non-Final Office Action, mailed 04 June 2008 have been withdrawn.
4. Applicant's arguments, see page 7, filed 04 November 2008, with respect to the specification have been fully considered and are persuasive. The objection to the specification of a Non-Final Office Action, mailed 04 June 2008 has been withdrawn.
5. Applicant's arguments, see pages 8-9, filed 04 November 2008, with respect to the rejection(s) of claim(s) 1-14 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

6. Applicant's arguments filed 04 November 2008 have been fully considered but they are not persuasive for the reasons set forth below.

Applicant argues:

**35 U.S.C. 101**

(1) "The Examiner indicates that he construes a browser-compatible user interface as software per se, yet provides no documentation to support this conclusion."

The Examiner disagrees. In a Non-Final Office Action, the Examiner cited the Applicant's disclosure, see page 5, lines 19-24, which state "...includes one or more or more search engines, and other modules and software, such as browser-compatible user-interface elements (UIEs) for receiving and fulfilling queries from clients." Based on the aforementioned disclosure, the Examiner interprets browser-compatible user-interface as software per se and therefore is non-statutory.

**35 U.S.C. 103**

(1) "The Applicant argues that Rivette does not set forth a prima facie case of obviousness of the claimed invention.

The Examiner disagrees and has addressed this argument in the rejection below.

(2) "As per claim 13, Rivette lacks the requisite user interface that enables a user at a law firm workstation within the law firm firewall to access internal law firm work

product documents stored in the law-firm information management system and external case laws documents by initiation or submitted single query via the interface."

The Examiner disagrees and has addressed this argument in (1) and (2).

(3) "Barney does not teach such information is provided in first and second separated databases or that even if they were in separate databases that the second database is outside or external to the system including the first database."

The Examiner disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of Rivette and Barney teach such information is provided in first and second separated databases or that even if they were in separate databases that the second database is outside or external to the system including the first database (see the combination of figures 3-5 which teach information is provided in first and second separated databases.)(Rivette, Figures 3-5).

Hence, the Applicant's arguments do not distinguish over the claimed invention over the prior art of record.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: Claim 12 recites 'a machine-readable medium,' which is not supported by the Applicant's disclosure. For the purpose of examination, the definition of machine-readable medium is taken to include only statutory embodiments.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 recites a 'browser-compatible user interface,' which the Applicant describes in the disclosure, see page 5, lines 19-24, which state "...includes one or more or more search engines, and other modules and software, such as browser-compatible user-interface elements (UIEs) for receiving and fulfilling queries from clients." The Examiner interprets browser-compatible user-interface as software *per se* and therefore is non-statutory.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d

at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette)(previously presented).

As per claim 1, Rivette teaches a computer system comprising: means for receiving a query from an agent of a law firm (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.") (Column 28, lines 28-35); means, responsive to the received query (i.e. "The searching module 410 in the enterprise server 314 receives the query request 908A.") (Column 29, lines 52-54), for searching at least first and second physical or logical databases (i.e. see Figure 5 for illustration that establishes a relationship between servers and databases. The Examiner interprets servers and databases to be at least more than one server and database, thereby reasonably anticipating the a relationship between the first and second server) (Figure 5) for content related to the query (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306.") (Column 25, lines 39-42), with the first database being a part of an information management system (see Figure 4 that describes server configuration for at least one database that includes document storage and retrieval module, whereby the first database is illustrated as at least one database. Item 314 is interpreted as an information management system.) (See Figure 4) for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm (i.e. "The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases.") (Column 3, lines 64-66) and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. "The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases." The first database containing briefs, client



correspondence, advisory opinions, or legal memoranda are illustrations of legal documents of the law firm are the intended use of the first database. Similarly patents are examples of legal documents that too may reside in a first database.)(Column 3, lines 60-67; column 4, lines 1-2).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette to include the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

As per claim 2, Rivette teaches a system, wherein the first and second databases are separated by a firewall (i.e. "The security module 402 performs the steps of flowchart 11002 to determine whether a user who is requesting an operation involving a data item has sufficient security access privileges with respect to that data item. Preferably, all operations performed by the enterprise server 314 are security checked. In other embodiments, only some operations performed by the enterprise server 314 are security checked. For example, operations involving reading patent documents are not security checked in some embodiments because patents are widely available public documents.")(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents include briefs, client correspondence, advisory opinions, or legal memoranda produced by the law firm (i.e. "Each of the groups comprises any number of patents from the first

databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604.

The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion associated with an indicator that indicates the document is a work-product document is further associated with information identifying an author of the document, an office location of the author, and an identification of documents within a document management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710

generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902."(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of each document found by the means for searching, with each displayed portion associated with: a selectively displayable table of authorities listing documents cited within the document; a selectively displayable listing of other documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58."(Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-product documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58."(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative degree to which the listed document treats the legal case and one or more of the listed work-product documents are associated with a feedback indicator selectable to view one or more user comments on the one or more listed work-product documents (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents found by the means for searching includes a selection device for invoking display of text of the document, with text including one or more selectable citations to other corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed

is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10, 12-14, Rivette teaches a system comprising providing an interface (see Figure 11, item 1124, "display unit" and Figure 8, item 304, which describes a web client. The Examiner interprets the display unit to be the requisite interface and displaying search results are provided through the web client which displays such results)(See Figures 8 and 11) for an online legal research service, wherein the interface enables an authorized law firm user to view search results (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35) including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306." "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 25, lines 39-42; column 26, lines 60-67).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette to include the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

As per claim 11, Rivette teaches the method wherein the law-firm content is stored in a law-firm information management system (see item 302, Figure 3) that includes a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e. user)(Figure 2) and is separated from the online legal service by a firewall (i.e. Network)(Figure 3).

12. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette) (previously presented) in view of Barney et al (U.S. Patent No. 6,556,992 B1 and known hereinafter as Barney) (previously presented).

As per claim 1, Rivette teaches a computer system comprising: means for receiving a query from an agent of a law firm (i.e. " Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the

field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35); means, responsive to the received query (i.e. "The searching module 410 in the enterprise server 314 receives the query request 908A.")(Column 29, lines 52-54), for searching at least first and second physical or logical databases for content related to the query (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306.")(Column 25, lines 39-42), with the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm (i.e. "The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66) and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

Rivette does not explicitly teach the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories.

Barney teaches the first database being a part of an information management system for the law firm (i.e. "a first database") (column 11, lines 1-67) including briefs, client



correspondence, advisory opinions, or legal memoranda of the law firm (i.e. *"Such information might include prior art that was not cited in the patent, possible license terms, potential problems with the written description or claims of the patent, information about the inventors, information relating to sales of patented products prior to the filing date, legal opinions, related litigation, and any other information that might be relevant to the patent."*)(column 11, lines 1-67) and the second database (i.e. *"a second database"*) (column 11, lines 1-67) being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. *"Examples of indirect patent metrics include reported patent litigation results, published case opinions, patent licenses, marking of patented products, and the like."*) (column 11, lines 1-67).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette with the teachings of Barney to include the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

As per claim 2, Rivette teaches a system, wherein the first and second databases are separated by a firewall (i.e. *"The security module 402 performs the steps of flowchart 11002 to determine whether a user who is requesting an operation involving a data item has sufficient security access privileges with respect to that data item. Preferably, all operations performed by*

the enterprise server 314 are security checked. In other embodiments, only some operations performed by the enterprise server 314 are security checked. For example, operations involving reading patent documents are not security checked in some embodiments because patents are widely available public documents."(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents include briefs, client correspondence, advisory opinions, or legal memoranda produced by the law firm (i.e. "Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710

generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902." (Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc." (Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion associated with an indicator that indicates the document is a work-product document is further associated with information identifying an author of the document, an office location of the author, and an identification of documents within a document management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic

information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902."(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of each document found by the means for searching, with each displayed portion associated with: a selectively displayable table of authorities listing documents cited within the document; a selectively displayable listing of other documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58."(Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-product documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document

being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58."(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative degree to which the listed document treats the legal case and one or more of the listed work-product documents are associated with a feedback indicator selectable to view one or more user comments on the one or more listed work-product documents (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58."(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents found by the means for searching includes a selection device for invoking display of text of the document, with text including one or more selectable citations to other

corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10, 12-14, Rivette teaches a system comprising providing an interface for an online legal research service, wherein the interface enables an authorized law firm user to view search results (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.") (Column 28, lines 28-35) including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306." "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710

supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57."(Column 25, lines 39-42; column 26, lines 60-67).

As per claim 11, Rivette teaches the method wherein the law-firm content is stored in a law-firm information management system (see item 302, Figure 3) that includes a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e. user)(Figure 2) and is separated from the online legal service by a firewall (i.e. Network)(Figure 3).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhan M. Syed whose telephone number is 571-272-7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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